REMARKS

Claims 1-9 are pending in this application. Claim 1 is independent. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph; and rejected claims 1, 2, 3, and 7 under 35 U.S.C. § 102(e) as being anticipated by *Szczebak, Jr. et al.* (USP 5,640,433). Applicants respectfully traverse these rejections.

Applicants wish to thank the Examiner for noting claims 4, 5, 6, 8, and 9 contain allowable subject matter.

Claim Rejections - 35 U.S.C. § 112

By this Amendment, Applicants have amended claim 1 solely to address the Examiner's rejection of this claim under 35 U.S.C. § 112. Based upon the amendment to claim 1, it is respectfully submitted that the requirements under 35 U.S.C. § 112 are now met and, thus, it is respectfully requested that the outstanding rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 102

The Examiner asserts that *Szczebak, Jr. et al.* teaches an adjustment unit for adjusting timing of input of the data output from the synchronous system (asserting *Szczebak, Jr. et al.* adjusts

timing of data output from synchronous system, citing to Fig. 15c: 872 has data and clock; 916 and 930 shift data which adjusts timing of the data; Fig. 14: 116 converts data from synchronous to asynchronous and thus inherently adjusts timing) and the data transmitted in the asynchronous system (asserting Szczebak, Jr. et al. adjusts timing of the data transmitted in the asynchronous system, citing to Fig. 15 and Fig. 14: 116 converts data from asynchronous to synchronous and thus inherently adjusts timing). Applicants respectfully disagree with the Examiner's characterization of this reference.

The disclosure of *Szczebak, Jr. et al.* is directed to a method and apparatus for testing telephone lines and telephone equipment such as analog private lines for voice and data communication. The system includes a circuit for converting DDS synchronous data transmissions into asynchronous transmissions, and vice versa, using a digital processor and associated circuits. A transceiver is coupled to the digital processor to receive and transmit on respective synchronous buses. The processor is connected to an asynchronous bus for receiving and transmitting asynchronous data. The positive and negative polarity pulses of synchronous transmissions received by the receiver are converted to separate pulses and coupled to the digital processor, as well as clock signals recovered from the synchronous transmission. The clock

signals provide an interrupt to the digital processor to process the synchronous pulses and convert the same to an asynchronous format.

Applicants respectfully disagree with the Examiner's assertion that it is inherent for a system that converts data from synchronous to asynchronous transmission to adjust the timing. While the Examiner's assertion may be true for some systems, it is not true for all systems. For example, in a system where asynchronous band width greatly exceeds the band width of the synchronous system, where synchronous bursts of data are controlled by commands or interrupt signals, a conversion from asynchronous to synchronous transmission would not necessarily involve the timing adjustment of the asynchronous signal. In this example, time periods where there is no communication in the asynchronous signal may correspond to zeros or a dedicated symbol where the timing is not adjusted. Thus, it is respectfully submitted that it is not inherent for a system that converts data from synchronous to asynchronous transmission to adjust the timing.

It is respectfully submitted that the court in *In re Robertson* held "to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may

not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Additionally, based upon the Examiner's failure to provide a reference that teaches or suggests all of the claimed elements, the Examiner has failed to meet his burden in establishing a *prima facie* case of anticipation under 35 U.S.C. § 102. Thus, it is respectfully requested, for the reasons set forth above, that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2, 3, and 7 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

Improper Finality of the Outstanding Official Action

In the Office Action mailed September 13, 2002, the Examiner rejected claims 1-3 and 7 under 35 U.S.C. § 102(b) as being anticipated by *Muramatsu et al.* The Examiner additionally rejected claim 1 under 35 U.S.C. § 112, second paragraph. In an attempt to satisfy the requirements under 35 U.S.C. § 112, Applicants amended claim 1 to more appropriately recite the present invention. Applicants further indicated that the amendments were being made solely to address the 35 U.S.C. § 112, second paragraph rejection.

In the outstanding Official Action, the Examiner withdrew his rejection of the claims under 35 U.S.C. § 102(b) as being anticipated by *Muramatsu et al.* and has asserted new art against claims 1-3 and 7 under 35 U.S.C. § 102(e), namely *Szczebak, Jr. et al.*

As the amendment to claim 1 did not affect the scope of the claim and the amendment was made merely to address the 35 U.S.C. § 112 rejection, the withdrawal of the prior art rejection as being anticipated by *Muramatsu et al.* was not necessitated by Applicants' amendment to the claim. As such, the finality of the outstanding Official Action is improper.

As noted in MPEP § 706.07(a), subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c). As the Examiner introduced a new ground of rejection that was not necessitated by Applicants' amendment of the claims nor based on information submitted in an Information Disclosure Statement, it is respectfully submitted that the finality of the outstanding Official Action is improper, and it is respectfully requested that the finality be withdrawn.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants respectfully petition for a two (2) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of $420.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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